

U.S. Parent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

REMARKS

Claims 1, 2, 4-19, 21-28 and 66 are pending in this application. Claims 3, 20 and 69-72 have been canceled. Claims 1, 5, 8, 17, 18, 22, 24, 28 and 66 have been amended. No new matter has been added by way of amendment. Support for the amendments to claims 1, 5, 8, 17, 18, 22, 24, 28 and 66 can be found at least in the Specification as originally filed at p. 5, line 21 to p. 6, line 8; p. 9, lines 3-22; p. 18, lines 1-5; claims 1-68; Fig. 1; Fig. 3.

Claims 1, 2, 10-11, 15-16, 18-19, 25, 27 and 66 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by European Patent Application No EP 1-014-318 A2 to Yamaguchi ("Yamaguchi"). Claims 4-9, 12-13, 17, 21-24, 26 and 28 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of U.S. Patent No. 6,390,362 to Martin ("Martin"). Claim 14 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of U.S. Patent No. 5,432,506 to Chapman ("Chapman").

Applicants previously amended the Specification in the Submission accompanying the Request for Continued Examination dated September 23, 2005, and request confirmation from the Examiner that this amendment has been accepted.

I. Restriction Requirement.

The Examiner has required an election made between the claims as set forth below:

- I. Claim 1-28 and 66, drawn to a method and system for generation of printable certified electronic financial instruments, which include digital watermark for security and verification classified in class 705 subclass 33;
- II. Claims 29-65 and 67, drawn to a method and system for distribution and verification of a printable certified electronic financial instrument containing digital watermarks for security and verifying the authenticity of the printed instrument classified in class 283 subclass 72; and
- III. Claim 68, drawn to a printer apparatus capable of printing composite images classified in class 358 subclass 450.

Applicants respectfully submit that claims 29-65, 67 and 68 were previously canceled. See Amendment after Final Rejection, August 18, 2005; Request for Continued Examination, September 23, 2005 (requesting that Amendment after Final Rejection dated August 18, 2005 be

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

entered as Submission Required under 37 C.F.R. § 1.114). *See also* Office Action dated November 19, 2004 at ¶ 3.

Applicants have canceled claims 69-72 in response to the Examiner's request in that these claims are directed to a non-elected invention.

II. Claim Rejections Under 35 U.S.C. § 102(a).

Claims 1, 2, 10-11, 15-16, 18-19, 25, 27 and 66 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Yamaguchi. *See* Office Action at ¶ 13. Applicants respectfully submit that Yamaguchi does not disclose each and every element of claims 1, 18 and 66, as amended, and therefore does not anticipate claims 1, 18 and 66, or any claims dependent from claims 1, 18 and 66, and that this rejection should be withdrawn. Applicants further note that this rejection is moot as to claims 3 and 20, which have been canceled.

A. Claims 1, 18 and 66.

The Examiner states that Yamaguchi discloses a "system, its method and electronically readable medium for remotely generating an instrument comprising: a) a processor that receives from a customer a request for the instrument (See Yamaguchi abstract, figures 2 step S8 and paragraph [0010] and [0023]); b) generates the instrument in electronic form (See Yamaguchi abstract, figures 2 step S11, and paragraph [0010]-[0013] and [0025]); c) adds a first security image in electronic form to the electronic form of the instrument to create a composite image (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]); and d) a communications module that transmits the composite image in electronic form to the customer for printing by the customer (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]-[0026], where transmits corresponds to sent). Wherein the first security image is visible on the instrument printed on the medium (See Yamaguchi figures 2-5, 9, 22, and 23 and related text, paragraphs [0034]-[0036] and [0087])." *See* Office Action at ¶ 14. (emphasis in original).

Applicants respectfully submit that Yamaguchi does not disclose at least the limitation of claims 1, 18 and 66 as amended of a system or its method of transmitting to a customer an instrument remotely generated in electronic form to which a first security image in electronic form has been added to form a composite image for printing by the customer on a medium,

U.S. Patent Appln. Serial No. 09/800,997

Amendment and Response to Office Action dated October 18, 2005

December 28, 2005

wherein the first security image is visible in the composite image that is printed on the instrument and invisible on a photocopy of the instrument.

Yamaguchi discloses a system and method for issuing tickets or postage stamps via a network or telephone line. *See* Yamaguchi, [0010]. The systems and methods of Yamaguchi disclose making **security data** from ticket issue request data and user identification data sent from a user via a communications means, making **ticket image data** from the ticket issue request data and transmitting to the user **ticket printing data** made by embedding the **security data** in the **ticket image data**. *See* Yamaguchi, [0010]-[0013]; [0029]; [0034]-[0036]; claims 1, 15, 16; Figs. 5, 22, 23. The system and method of Yamaguchi thus include using ticket issue request data and/or user identification data sent from a user to prepare four types of data: (1) **security data**; (2) **ticket image data**; (3) **ticket printing data** (a composite of the **security data** and the **ticket image data**); and (4) **ticket display data**. *See* Yamaguchi, [0010], [0025]. None of these data, however, are *visible* when a composite image (*i.e.*, **ticket printing data** which is a composite of the **ticket image data** and the **security data**) is printed on ticket paper by the user, and *invisible* when the printed ticket is photocopied. Therefore, Yamaguchi does not disclose each and every limitation of claims 1, 18 and 66 and does not anticipate these claims.

Specifically, in the system and method of Yamaguchi, a user connects a user terminal to the host computer/server by inputting user identification data, and the host computer/server approves or rejects the connection. *See* Yamaguchi, [0021]-[0022]. Once connected, a service menu is displayed on the user terminal device and the user inputs ticket issue request data relating to a desired ticket, date and time, charge, seat reservation, charge paying means, *etc.* which are transmitted to the host computer/server. *See* Yamaguchi, [0023]-[0024]. If the requested ticket is purchasable, the host computer/server outputs **security data** from the ticket issue request data and the user identification data. *See* Yamaguchi, [0025]. **Ticket image data** are formed from the ticket issue request data received from the user. *See id.* **Ticket printing data** are a composite image formed by embedding the **security data** in the **ticket image data**. *See id.* **Ticket display data** are prepared based on the **ticket printing data**. *See id.* The **ticket printing data** and the **ticket display data** are transmitted to the user terminal. *See id.*

The **ticket display data** are displayed on the user terminal display device so that the user

can check the display to see that there is no problem before printing the ticket. *See Yamaguchi, [0026].* When the user executes a print command, the composite image (*i.e.*, the **ticket printing data**) is sent from the user terminal to the ticket printer and a ticket is printed and outputted. *See id.* The user can use the printed ticket in the usual manner. *See id.* However, for security purposes, the genuineness of the ticket is checked using a security data detecting system which collates detected **security data** from the ticket with data stored in a database. *See Yamaguchi, [0027].*

The **security data** are embedded in the **ticket image data** to form a composite image (the **ticket printing data**) such that the **security data** are invisible against the **ticket image data** when the **ticket printing data** (including the **security data** and the **ticket image data**) are printed on a ticket paper. *See Yamaguchi, [0010]; [0012]; [0013]; [0025]; [0034]-[0036]; [0050]; [0085].* The **security data** are composed of two-dimensional code data and a binary image. *See Yamaguchi, [0038].* The two dimensional code is created by first digitizing basic **security data**. *See Yamaguchi, [0039]; [0042].* The digitized basic **security data** are converted into a binary image in two-dimensional code, applying for example Calra code, matrix system two-dimensional codes or Glyph codes. *See Yamaguchi, [0043]; [0046].* The binary image data are expanded, and the two-dimensional code data and binary image data are arranged in the same size area as the **ticket image data**. *See Yamaguchi, [0045]; [0046]; [0048].*

Next, a composite processing method is performed to create the **ticket printing data**. *See Yamaguchi, [0049]-[0050].* In the composite processing method, the two-dimensional code data and binary image data made from the **security data** undergo a smoothing process with the black pixels made "1" and the white pixels made "0". *See Yamaguchi, [0051].* Next, a phase modulation process is performed on the result of the smoothing process using key image data. *See Yamaguchi, [0051], [0053]; [0054]; Fig. 9.* Key image data are data that become a key for making the **ticket printing data** and for detecting (restoring) the **security data**. *See Yamaguchi, [0050].*

A color difference modulation process for the three components of Red, Green and Blue for each pixel is then performed on the result of the phase modulation process. *See Yamaguchi, [0056]; Fig. 9.* In the color difference modulation process, a color difference amount used in the

U.S. Patent Appln. Serial No. 09/800,997

Amendment and Response to Office Action dated October 18, 2005

December 28, 2005

process is preset; the higher the color difference amount, the more the visible contrast when restoring the embedded image, but too high a color difference amount can disclose the **security data**. See Yamaguchi, [0056]; [0057]. Further, the color difference amounts are reversed for Red as compared to Green and Blue. See *id.* Yamaguchi discloses that Red and (Green, Blue) = Cyan are complementary colors such that when they are adjacent to each other, the human eye cannot distinguish them. See Yamaguchi, [0061]; [0062].

Finally, the result of the color difference modulation process is superimposed on the **ticket image data** to create the **ticket printing data**. See Yamaguchi, [0058]; Fig. 9. The result of these processes is to form a composite image - **ticket printing data** - by invisibly embedding **security data** in **ticket image data**. See Yamaguchi, [0062].

For judging genuineness of the printed ticket, the **security data** can later be restored when the printed ticket is read by an optical reading means such as a scanner digitized to a certain state using the key image data that were used to create the **ticket printing data**. See Yamaguchi, [0073]-[0075]; [0082]. The **security data** can also be restored by superimposing a reproduction sheet having the same pattern transmission factor as the key image data on the printed surface of the ticket which makes the **security data** become visible. See Yamaguchi, [0079]. Additionally, **security data** can be restored by thinning a value read by an optical means. See Yamaguchi, [0080]-[0081].

Thus, Yamaguchi discloses a composite image - the **ticket printing data** - that are printed by a customer on a medium to create a ticket, which composite image is made by adding a first security image - the **security data** - to an electronic form of the ticket - the **ticket image data**.¹ However, there is no disclosure in Yamaguchi that any of the **security data**, the **ticket image data** or the **ticket printing data** are both *visible* when the composite image (the **ticket printing data**) is printed on a medium to create the instrument, where that same data are *invisible* on a photocopy of the instrument, as required by each of claims 1, 18 and 66. Rather, the **security data** of Yamaguchi are *invisible* when the **ticket printing data** (*i.e.*, the composite

¹ The **ticket image data** are the data of "the so-called ticket itself." See Yamaguchi, [0050]; see also Fig. 3.

U.S. Patent Appln. Serial No. 09/800,997

Amendment and Response to Office Action dated October 18, 2005

December 28, 2005

image) are printed on a ticket. The **security data** disclosed in Yamaguchi therefore does not meet these limitations of claim 1, 18 and 66. *See* Yamaguchi, [0010] at lines 44-45; [0012] at lines 57-58; [0013] at lines 6-7; [0034]; [0088]; [0091]; [0092]; Figs. 3-5. Neither do the **ticket image data** or the **ticket printing data** meet these limitations, either. The **ticket image data** are *visible* when printed on the ticket as part of the **ticket printing data** (*i.e.*, the composite image). *See* Yamaguchi, [0029]; Figs. 3, 5. However, there is no disclosure in Yamaguchi that the **ticket image data** or **ticket printing data** are *invisible* on a photocopy of the ticket. *See* Yamaguchi, [0050]. Thus, there is no disclosure in Yamaguchi of data that are **both visible** on the printed instrument and *invisible* on a photocopy of the instrument, as required by claims 1, 18 and 66.²

The Examiner asserts that Yamaguchi discloses an embodiment where the first security image is invisible on a photocopy of the instrument printed on a medium. *See* Office Action at ¶ 16. In support, the Examiner cites to Yamaguchi at Abstract, Fig. 2 step S12, and paragraphs [0010]-[0013], [0034]-[0035] and [0084]-[0087]. Applicants respectfully submit that the Abstract, Fig. 2 Step S12, paras. [0010]-[0013] and [0034]-[0035] disclose only **security data** embedded in **ticket image data** that are *invisible* when **ticket printing data**, comprising the **security data** and the **ticket image data**, are printed on ticket paper by a user. Regardless of whether the **security data** (or first security image) are invisible *on a photocopy* of the instrument, these sections clearly disclose that the first security image is *invisible* on the printed

² The Examiner cites to Yamaguchi at Figs. 2-5, 9, 22 and 23; [0087]; and [0034]-[0036] as teaching the printing of visible and invisible image data to be printed on a medium. *See* Office Action at ¶ 4 (beginning on p. 2 - note that there is a second ¶ 4 beginning on p. 3 in the Restriction Requirement section). However, these sections of Yamaguchi do not teach that the *same* data are *visible* on the printed instrument, but *invisible* on a photocopy of the printed instrument. For example, Fig. 3 depicts **ticket image data** that are generated from user issue request data; Fig. 4 depicts **security data** generated from user identification data and the ticket issue request data during the process in Step S10 of Fig. 2. *See* Yamaguchi, [0029]. Fig. 5 depicts the **ticket printing data** which are printed on ticket paper. *See id.* As can be seen, items 39, 40, 41 and 42 of Fig. 4 - **security data** - are *invisible* in the printed ticket of Fig. 5, not *visible* as required by claims 1, 18 and 66. While the logo is visible in Fig. 5, the logo 38 is included in the **ticket image data** of Fig. 3 such that the logo 38 is *visible* on both the printed ticket *and* a photocopy of the ticket, and also does not satisfy the limitations of claims 1, 18 and 66.

U.S. Patent Appln. Serial No. 09/800,997

Amendment and Response to Office Action dated October 18, 2005

December 28, 2005

ticket, and thus these sections do not disclose each and every limitation of claims 1, 18 and 66.³

Yamaguchi discloses a particular embodiment which prevents copying of a ticket; however, this embodiment discloses a method to cause **security data** to not be properly copied so they cannot be restored for security purposes by the security data detecting system. This embodiment includes the use of a checkered pattern of 4x2 pixels or 1x1 pixels as a key during the process of composing the **ticket printing data** from the **security data**. See Yamaguchi, [0049]-[0054]; [0083] at lines 9-10. When the ticket thus printed is copied, the sensor of the scanner cannot separate the complementary Red and (Green, Blue) = Cyan pixels in the **security data**, causing the **security data** to be erroneously recognized by human eyes and sensors as grey. See Yamaguchi, [0083], [0084]. The **security data** in this embodiment are thus *invisible* on the photocopy and *invisible* when the **ticket printing data** (comprising **security data** and **ticket image data**) are printed on ticket paper by a user. This embodiment does not disclose the limitation of claims 1, 18 and 66 of a first security image that is *visible* in a composite image that is printed on an instrument and *invisible* on a photocopy of the instrument, either. Thus, the Examiner's citations to Yamaguchi at [0084]-[0087] do not disclose these limitations of claims 1, 18 and 66, and Yamaguchi does not anticipate these claims.

Since Yamaguchi does not disclose each and every limitation of claims 1, 18 and 66, and specifically does not disclose the limitation of a first security image that is *visible* in the composite image (*i.e.*, the **security data** and the **ticket image data** to form the **ticket printing data**) that is printed on the instrument and *invisible* on a photocopy of the instrument, Applicants respectfully request that this rejection be withdrawn against claims 1, 18 and 66.

B. Claims 2 and 19.

The Examiner states that as per claims 2 and 19, Yamaguchi discloses "all the limitations of claims 1 and 18, wherein the first security image comprises a watermark that appears as a part

³ While Yamaguchi at [0013] and [0025] discloses that the **security data** are visible when printed on a paper, Yamaguchi in those same sections additionally states that the **security data** are *invisible* when printed in the composite image (*i.e.*, when printed against the **ticket image data** when the **ticket printing data** are printed on ticket paper). Thus, these sections do not disclose each and every limitation of claims 1, 18 and 66, either.

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

of the composite image when printed (See Yamaguchi figures 3-8, paragraphs [0034], [0044], [0049]-[0050] and [0062], where watermark corresponds to data to be embedded in the image data in the invisible state)." See Office Action at ¶ 15.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claims 2 and 19, which depend from claims 1 and 18, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 2 and 19.

C. Claims 3 and 20.

Applicants respectfully submit that this rejection is moot as to claims 3 and 20 which have been canceled. Applicants addressed the grounds of this rejection with respect to claims 1, 18 and 66 in Sec. I(A) *supra*.

D. Claim 10.

The Examiner states that as per claim 10, Yamaguchi discloses "all the limitations of claim 1, wherein the instrument comprises a monetary instrument (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money)." See Office Action at ¶ 17.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claim 10, which depends from claim 1, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 10.

E. Claim 11.

The Examiner states that as per claim 11, Yamaguchi discloses "all the limitations of claim 10, wherein the instrument represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money like postage stamps. Stamps are certified funds used for variety of transactions and fee payments especially in official correspondence)." See Office Action at ¶ 18.

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

Applicants respectfully submit that at least for the reasons stated in Sec. I(D) *supra* that Yamaguchi does not disclose each and every limitation of claim 11, which depends from claim 10, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 11.

F. Claim 15.

The Examiner states that as per claim 15, Yamaguchi discloses "all the limitations of claim 10, wherein the request comprises at least one of an amount, a denomination and a currency of the monetary instrument (See Yamaguchi figure 3, and paragraphs [0010]-[0013] [0023] and [0031])." See Office Action at ¶ 19.

Applicants respectfully submit that at least for the reasons stated in Sec. I(D) *supra* that Yamaguchi does not disclose each and every limitation of claim 15, which depends from claim 10, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 15.

G. Claims 16 and 27.

The Examiner states that as per claims 16 and 27, Yamaguchi discloses "all the limitations of claims 1 and 18, further comprising a step of e) associating a unique identifier number with the instrument (See Yamaguchi figure 3, and paragraphs [0010]-[0013] [0023], [0031] and [0035])." See Office Action at ¶ 20.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claims 16 and 27, which depend from claims 1 and 18 respectively, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 16 and 27.

H. Claim 25.

The Examiner states that as per claim 25, Yamaguchi discloses "all the limitations of claim 18, wherein the instrument comprises a monetary instrument that represents certified funds

U.S. Patent Appln. Serial No. 09/800,997

Amendment and Response to Office Action dated October 18, 2005

December 28, 2005

(See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money) and the instrument represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money like postage stamps. Stamps are certified funds used for a variety of transactions and fee payments especially in official correspondence).” See Office Action at ¶ 21.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claim 25, which depends from claims 18 and 23, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 25.

III. Claim Rejections Under 35 U.S.C. § 103(a).

Claims 4-9, 12-13, 17, 21-24, 26 and 28 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of Martin. See Office Action at ¶ 24. Claim 14 has been rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of Chapman. See Office Action at ¶ 32. Applicants respectfully submit that neither Yamaguchi in combination with Martin nor Yamaguchi in combination with Chapman disclose each and every limitation of claims 4-9, 12-14, 17, 21-24, 26 and 28, and that this rejection be withdrawn for failing to form a *prima facie* case of obviousness.

A. Claims 4-6 and 21-22.

The Examiner states that Yamaguchi discloses all the limitations of claims 3 and 20, and that Martin “clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied and displaying the word ‘Void’ (See Martin, column 2, lines 11-15 and 21-24 and column 4, lines 21-39).” See Office Action at ¶ 25. According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.” *Id.*

U.S. Patent Appln. Serial No. 09/800,997

Amendment and Response to Office Action dated October 18, 2005

December 28, 2005

Applicants respectfully submit that, as discussed in Sec. I(A) *supra*, Yamaguchi does not disclose at least the limitation of claims 1 and 18 of a system or its method of transmitting to a customer an instrument remotely generated in electronic form to which a first security image in electronic form has been added to form a composite image for printing by the customer on a medium, wherein the first security image is visible in the composite image that is printed on the instrument and invisible on a photocopy of the instrument. Rather, Yamaguchi discloses **security data** that are *invisible* in the composite image (**ticket printing data**) printed on ticket paper by a user, and also are *invisible* when copied. *See* Yamaguchi, [0010], line 44-45; [0012], lines 57-58; [0013], lines 6-7; [0034], lines 7-8; [0050], lines 57-58; [0062], lines 48-49; [0088], lines 31-32; [0091], lines 41-42; [0092], lines 44-45; claims 1, 15, 16; Figs. 5, 22, 23. Yamaguchi also discloses **ticket printing data** comprising **security data** and **ticket image data** that are *visible* in a composite image when printed on ticket paper by a user, but there is no disclosure that the **ticket printing data** or the **ticket image data** are *invisible* in a photocopy of the instrument.

Martin does not disclose the limitations that are missing in Yamaguchi, either. Martin discloses an inventive check that includes a barcode, which includes at least one of the following pieces of information: the date the check was paid, the amount of the check, the payee, the drawers account number, the bank's routing number, and the identifier number of the check. *See* Martin, Abstract; col. 4, lines 5-19; col. 5, lines 7-14; col. 7, lines 38-42. Martin also provides for a method for preventing check fraud which includes attaching a machine readable code on a negotiable instrument and creating a negotiable instrument, where the drawee receives the negotiable instrument and scans the machine readable bar code. *See* Martin, Abstract. However, Martin does not disclose at least the limitation of claims 1 and 18 of a system or its method of transmitting to a customer an instrument remotely generated in electronic form to which a first security image in electronic form has been added to form a composite image for printing by the customer on a medium, wherein the first security image is visible in the composite image that is printed on the instrument and invisible on a photocopy of the instrument.

Since claims 4-6 depend from claim 1 and claims 21-22 depend from claim 18, Yamaguchi in combination with Martin does not disclose each and every limitation of claims 4-6

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

and 21-22, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 4-6 and 21-22 for failure to form a *prima facie* case of obviousness.

B. Claims 7-9 and 23-24.

The Examiner states that Yamaguchi discloses all the limitations of claims 1 and 18, and that Martin "clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied and displaying the word "Void" (See Martin, column 2, lines 11-15 and 21-24 and column 4, lines 21-39). See Office Action at ¶ 26. According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention." *Id.*

As discussed *supra* in Sec. II(A), Yamaguchi in combination with Martin does not disclose each and every limitation of claims 1 and 18, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 7-9 and 23-24, which depend from claims 1 and 18, for failure to form a *prima facie* case of obviousness.

C. Claim 12.

The Examiner states that Yamaguchi discloses all the limitations of claim 11, and that Martin "clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payor's account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19)." See Office Action at ¶ 27. According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument." *Id.*

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

As discussed *supra* in Sec. II(A), Yamaguchi in combination with Martin does not disclose each and every limitation of claim 1 (from which claim 12 depends), and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 12, which depends from claims 1 and 11, for failure to form a *prima facie* case of obviousness.

D. Claim 13.

The Examiner states that Yamaguchi discloses all the limitations of claim 12, and that Martin “clearly discloses that the funds are withdrawn from the customer’s deposit account (See Martin abstract, column 3, line 55–column 4, line 2 and column 8, lines 10–19).” See Office Action at ¶ 28. According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution withdraw the funds from the account of the account holder for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.” *Id.*

As discussed *supra* in Sec. II(C), Yamaguchi in combination with Martin does not disclose each and every limitation of claim 12 (from which claim 13 depends), and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 13 for failure to form a *prima facie* case of obviousness.

E. Claim 26.

The Examiner states that Yamaguchi discloses all the limitations of claim 25, and that Martin “clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payor’s account held at the bank (See Martin abstract, column 3, line 55–column 4, line 2 and column 8, lines 10–19).” See Office Action at ¶ 29. According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

presence of the funds to cover such instrument.” *Id.*

As discussed *supra* in Sec. II(A), Yamaguchi in combination with Martin does not disclose each and every limitation of claim 18, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 26, which depends from claim 18, for failure to form a *prima facie* case of obviousness.

E. Claims 17 and 28.

The Examiner states that as per claims 17 and 28, Yamaguchi “is not explicit [that] the composite image is for printing on a medium having a second security image the second security image is invisible on the instrument and is visible on a photocopy of the instrument.” See Office Action at ¶ 30. According to the Examiner, “Martin clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied (See Martin, column 2, lines 11-15 and 21-24 and column 4, lines 21-39). *Id.* According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.” *Id.*

The Examiner further states that Yamaguchi is “not explicit and specific [that] the instrument is generated by an issuing financial institution, the funds are certified by the issuing financial institution and the customer holds a deposit account with the issuing financial institution.” *Id.* According to the Examiner, Martin “clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payor’s account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).” *Id.* According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.” *Id.*

U.S. Patent Appn. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

Applicants respectfully submit that, as discussed in Sec. II(A) *supra*, Applicants respectfully submit that, as discussed in Sec. I(A) *supra*, Yamaguchi does not disclose at least the limitation of claims 1 and 18 of a system or its method of transmitting to a customer an instrument remotely generated in electronic form to which a first security image in electronic form has been added to form a composite image for printing by the customer on a medium, wherein the first security image is visible in the composite image that is printed on the instrument and invisible on a photocopy of the instrument. Rather, Yamaguchi discloses security data that are *invisible* in the composite image (ticket printing data) printed on ticket paper by a user, and also are *invisible* in one embodiment when copied. See Yamaguchi, [0010], line 44-45; [0012], lines 57-58; [0013], lines 6-7; [0034], lines 7-8; [0050], lines 57-58; [0062], lines 48-49; [0088], lines 31-32; [0091], lines 41-42; [0092], lines 44-45; claims 1, 15, 16; Figs. 5, 22, 23. Yamaguchi also discloses ticket printing data comprising security data and ticket image data that are *visible* in a composite image when printed on ticket paper by a user, but there is no disclosure that the ticket printing data or the ticket image data are *invisible* in a photocopy of the instrument.

Martin similarly does not disclose the limitation of claims 17 and 28 of a system or its method of transmitting to a customer an instrument remotely generated in electronic form to which a first security image in electronic form has been added to form a composite image for printing by the customer on a medium, wherein the first security image is visible in the composite image that is printed on the instrument and invisible on a photocopy of the instrument.

Applicants respectfully submit that Yamaguchi in combination with Martin does not disclose each and every limitation of claims 17 and 28, and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 17 and 28 for failure to form a *prima facie* case of obviousness.

G. Claim 14.

The Examiner states that Yamaguchi discloses all the limitations of claim 10, and that Chapman "clearly discloses that the . . . instrument can be checks, money orders, stock

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

certificates, passports, other financial instruments, or other documents subject to counterfeiting and forgery (See Chapman abstract, column 1, lines 53-68, and column 4, lines 64-68).” See Office Action at ¶ 31. According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to include other financial instruments as well as other documents subject to counterfeiting and forgery such as bonds and stock certificates for the motivation of further broadening of the usefulness of the Yamaguchi’s invention.” *Id.*

As discussed in Sec. II(A), *supra*, Applicants respectfully submit that, as discussed in Sec. I(A) *supra*, Yamaguchi does not disclose at least the limitation of claims 1 and 18 of a system or its method of transmitting to a customer an instrument remotely generated in electronic form to which a first security image in electronic form has been added to form a composite image for printing by the customer on a medium, wherein the first security image is visible in the composite image that is printed on the instrument and invisible on a photocopy of the instrument. Rather, Yamaguchi discloses **security data** that are *invisible* in the composite image (**ticket printing data**) printed on ticket paper by a user, and also are *invisible* in one embodiment when copied. See Yamaguchi, [0010], line 44-45; [0012], lines 57-58; [0013], lines 6-7; [0034], lines 7-8; [0050], lines 57-58; [0062], lines 48-49; [0088], lines 31-32; [0091], lines 41-42; [0092], lines 44-45; claims 1, 15, 16; Figs. 5, 22, 23. Yamaguchi also discloses **ticket printing data** comprising **security data** and **ticket image data** that are *visible* in a composite image when printed on ticket paper by a user, but there is no disclosure that the **ticket printing data** or the **ticket image data** are *invisible* in a photocopy of the instrument.

Chapman discloses a system for verifying the authenticity of a document that bears a number of fields of strings of variable characters such as a check bearing date of issue field, payee field and numeric and alpha amount fields. See Chapman, Abstract; col. 2, lines 54-68.. The system of Chapman authenticates a document by entry of certain elements written or printed on an instrument into a computer, with the computer generating a code that it compares with a unique code on the instrument. See col. 1, lines 53-60. A mismatch between the generated code and the unique code on the instrument indicates fraud. See col. 1, lines 60-61. However, Chapman does not disclose at least the limitation of claim 1 of a system or its method of

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

transmitting to a customer an instrument remotely generated in electronic form to which a first security image in electronic form has been added to form a composite image for printing by the customer on a medium, wherein the first security image is visible in the composite image that is printed on the instrument and invisible on a photocopy of the instrument.

Applicants respectfully submit that Yamaguchi in combination with Chapman does not disclose each and every limitation of claim 14 (which depends from claim 1), and specifically does not disclose the limitation that the first security image is *visible* in the composite image that is printed on the instrument and *invisible* on a photocopy of the instrument. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 14 for failure to form a *prima facie* case of obviousness.

U.S. Patent Appln. Serial No. 09/800,997
Amendment and Response to Office Action dated October 18, 2005
December 28, 2005

CONCLUSION

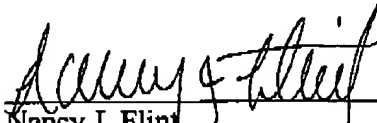
Applicants respectfully request that claims 1, 2, 4-19, 21-28 and 66 are in condition for allowance. This response has been filed within three (3) months of the mailing date of the Office Action and it is believed that no fees are due. If any fees are determined to be due, the Commissioner is hereby authorized to charge or credit that variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: December 28, 2005
Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(305) 810-2522 (telephone)
(305) 810-1615 (facsimile)
NJF/kmb

By:


Nancy J. Flint
Registration No. 46,704